

REMARKS

This amendment responds to the final office action mailed September 2, 2010. In the final office action the Examiner provisionally rejected claims 82-118 under obviousness-type double patenting as being unpatentable over claims of US Application Nos. 10/914,014 and 10/914,035.

The pending claims are claims 82-118.

Related Applications

The pending application is potentially related to:

App No.	Title
10/815,284	Dynamically Updating Transmission Characteristics in a Web Mail Reply
10/816,427	Email Conversation Management System
10/914,013	Browser-Based Spell Checker
10/914,014	Displaying Conversation Views in a Conversation-Based Email System
10/914,034	Providing Snippets Relevant to a Search Query in a Conversation-Based Email System
10/914,035	Displaying Conversations in a Conversation-Based Email System
10/914,036	NA
10/914,039	Associating Email Messages With Conversations
10/914,040	Conversation-based Email Messaging
11/522,549	Dynamically Updating Transmission Characteristics in a Web Mail Reply
11/961,911	Dynamically Updating Transmission Characteristics in a Web Mail Reply
12/618,669	Retrieving and Snoozing Categorized Conversations in a Conversation-Based Email System
12/618,673	Labeling Messages of Conversations and Snoozing Labels Conversation in a Conversation-Based Email System
12/834,808	Displaying Conversation Views in a Conversation-Based Email System
12/846,774	Conversation-based Email Messaging
12/892,839	Email Conversation Management System
12/892,842	Email Conversation Management System

The Examiner is encouraged to review the art made of record, Office Action(s) and the Notice of Allowance in the above-mentioned related application, all of which are available on PAIR.

INTERVIEW SUMMARY

The Applicant's Representative, Josh Olson thanks Examiner Dustin Nguyen for the opportunity to discuss this application in a telephone interview on October 29, 2010. During the interview, the Applicant's Representative and the Examiner discussed the double patenting rejections, and the Examiner provided an oral correction for a typographical error. In particular, the Examiner stated that the nonstatutory obviousness-type double patenting

rejection is with respect to the claims of U.S. Pat. App. Nos. 10/914,014 and 10/914,035 and is not a rejection with respect to the claims of U.S. Pat. App. Nos. 10/941,014 and 10/941,035, as incorrectly stated in the Office Action dated 9-2-10.

CLAIM REVISIONS

Claim 111 is cancelled.

Minor revisions to claims 82, 100, 109 and 118 have been made for clarity. No new matter has been added.

REMARKS CONCERNING DOUBLE PATENTING REJECTIONS

A. Rejection based on the claims of U.S. Pat. App. No. 10/914,014.

The Examiner provisionally rejected claims 82-118 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Pat. App. No. 10/914,014, which has issued as U.S. Pat. No. 7,818,378 on October 19, 2010. The attached terminal disclaimer disclaims the terminal part of any patent granted on the present application beyond the term of U.S. Pat. No. 7,818,378. Based on the terminal disclaimer, the Applicant respectfully requests that the double patenting rejections be withdrawn

B. Rejection based on the claims of U.S. Pat. App. No. 10/914,035.

The Examiner also provisionally rejected claims 82-118 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of co-pending U.S. Pat. App. No. 10/914,035. However, U.S. Pat. App. No. 10/914,035 has not yet been allowed, and thus the claims in that application have yet to be finalized. The Applicant will reconsider filing a terminal disclaimer when U.S. Pat. App. No. 10/914,035 receives a notice of allowance. Furthermore, Applicant submits that the pending claims in this application, as amended, are patentably distinct from the claims pending in co-pending application 10/914,035. The Applicant respectfully requests the Examiner to withdraw the rejections of the amended claims based on these grounds.

Moreover, the MPEP explicitly states that:

B. Between Copending Applications-Provisional Rejections

Occasionally, the examiner becomes aware of two copending applications that were filed by the same inventive entity, or by different inventive entities having a common inventor, and/or

by a common assignee, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3), that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); In re Wetterau, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application **unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications.**

1. Nonstatutory Double Patenting Rejections

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, **the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.** If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

(MPEP 804 I.B.1, emphasis added)

As shown above, if a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the Examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. Applicant notes that: (1) the present case is the earlier filed case (having been filed on 3-31-04, while U.S. Pat. App. No. 10/914,035 was filed on 8-6-04); (2) the Examiner's "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining; and (3) U.S. Pat. App. No. 10/914,035 (i.e., the later-filed application) is rejectable on other grounds (see, for example, the Office Action for U.S. Pat. App. No. 10/914,035 dated 6-11-10). For at least this additional reason, the Applicant respectfully request the Examiner to withdraw the rejections of the amended claims based on these grounds.

By responding in the foregoing remarks only to particular positions asserted by the Examiner, the Applicant does not necessarily acquiesce in other positions that have not been explicitly addressed. In addition, the Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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/ Gary S. Williams /

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Gary S. Williams

(Reg. No.)

MORGAN, LEWIS & BOCKIUS LLP

2 Palo Alto Square

3000 El Camino Real, Suite 700

Palo Alto, CA 94306

(650) 843-4000